

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Atty. Ref. No.: 016756/0211



04-16-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

BFS BRANDS, LLC

and

BRIDGESTONE/FIRESTONE
NORTH AMERICAN TIRE, LLC,

Opposers,

v.

ORTECK INTERNATIONAL INC.,

Applicant.

Opposition No. 154,661

Application Serial No. 76/369,339

TRANSMITTAL LETTER

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Madam:

Please find attached hereto the following items, in duplicate:

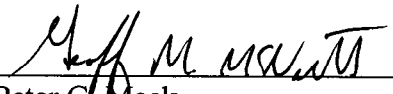
1. Amended Notice of Opposition (original);
2. Amended Notice of Opposition (black-line format);
3. Motion for Leave to Amend Notice of Opposition and Memorandum of Law in Support Thereof (with Exhibits A -C).

Should any additional fees become due, please charge them to Foley & Lardner's Deposit Account No. 19-0741.

April 16, 2004

FOLEY & LARDNER LLP
Suite 500
3000 K St., N.W.
Washington, D.C. 20007
202-672-5300

Respectfully submitted,

By: 
Peter G. Mack
Geoffrey McNutt
Counsel for Opposers

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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and :
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BRIDGESTONE/FIRESTONE :
NORTH AMERICAN TIRE, LLC, :
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Opposers, :
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Opposition No. 154,661

Application Serial No. 76/369,339

AMENDED NOTICE OF OPPOSITION

This is in the matter of an application for registration of the expression "MILESTONE ROAMER" for "tires for vehicle wheels", Serial No. 76/369,339, filed February 8, 2002 by Orteck International, Inc., having a business address at 1621B Iron Bridge Road, Jessup, Maryland 20794 (hereinafter called "Applicant"), and published for opposition in the *Official Gazette* of July 30, 2002.

BFS Brands, LLC, a Delaware limited liability company, having a business address at 50 Century Blvd., Nashville, Tennessee 37214, and Bridgestone/Firestone North American Tire, LLC, a Delaware limited liability company, having a business address at 1 Bridgestone Park,

Nashville, Tennessee 37214, believe that they would be damaged by registration of the mark in the foregoing application and hereby oppose the same.

The grounds for the opposition are as follows:

1. BFS Brands, LLC, and Bridgestone/Firestone North American Tire, LLC, (hereinafter referred to collectively as "Opposers") are wholly owned subsidiaries of Bridgestone/Firestone Americas Holding, Inc., and trace their ultimate origin to The Firestone Tire & Rubber Company (hereinafter called "Firestone").

2. By the application herein opposed, Applicant seeks to register "MILESTONE ROAMER" as a trademark for "tires for vehicle wheels", basing such application for United States federal registration on an intent to use the mark in commerce in connection with the identified goods. The constructive date of first use of Applicant's mark is the filing date of Applicant's application, February 8, 2002.

3. Opposers, as the successors in interest to Firestone, are the owner of all right, title and interest in and to various FIRESTONE marks for vehicle tires and for other goods and services. As used herein, "Opposers' goods," "Opposers' services," and "Opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Firestone, which is the ultimate predecessor in title of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC.

4. Opposer BFS Brands, LLC, is the owner of many U.S. Trademark and Service Mark Registrations featuring the mark FIRESTONE. Among such U.S. registrations are Reg. No.

140,804, registered March 29, 1921, for the mark FIRESTONE in a stylized form for rubber tires and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. 299,977; Reg. No. 378,189; Reg. No. 396,796; Reg. No. 401,421; Reg. No. 948,402; Reg. No. 1,178,631; Reg. 1,387,468; Reg. No. 1,445,182; Reg. No. 1,471,665; Reg. No. 1,685,164; Reg. No. 2,223,630; Reg. No. 2,464,005; Reg. No. 2,507,769; and Reg. No. 2,582,878.

5. Bridgestone/Firestone North American Tire, LLC owns App. No. 75/768,214 featuring the mark FIRESTONE, which has already successfully completed the opposition phase and for which a Notice of Allowance has issued. App. No. 75/768,214 was filed on August 5, 1999 and therefore has a constructive date of first use prior to any date upon which Applicant may rely in this proceeding.

6. Opposer Bridgestone/Firestone North American Tire, LLC, uses the registered FIRESTONE marks owned by Opposer BFS Brands, LLC, with the authorization of the latter entity.

7. The term FIRESTONE was adopted as a mark and name by The Firestone Tire & Rubber Company, the ultimate predecessor of both Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, more than one hundred years ago, in January, 1896. The FIRESTONE mark and name has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of Opposers' tires and other goods in interstate commerce; and is still in such use by Opposers.

8. Opposers use trade names and corporate identifiers dominated by the name "Bridgestone/Firestone." Such Bridgestone/Firestone name and identifier have been in use since long

prior to any date on which Applicant may rely in this proceeding. In this regard, the ultimate parent company of Opposers is Bridgestone Corporation; and the mark and name BRIDGESTONE is often used with the mark and name FIRESTONE to create a unitary impression conveyed by a composite of the two marks and names BRIDGESTONE and FIRESTONE. Also, Firestone has a website accessed, not only by its domain name <firestone.com>, but also by its domain name <bridgestone-firestone.com>. Thus, as used herein, the expression “Bridgestone/Firestone name” and expressions to the same effect encompass the aforesaid Bridgestone/Firestone trade name and corporate identifier, the aforesaid composite expression composed of the terms BRIDGESTONE and FIRESTONE, and the aforesaid <bridgestone-firestone.com> domain name.

9. The FIRESTONE names and marks and the Bridgestone/Firestone name are of significant value to Opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods and services of Opposers and their affiliates, as well as in the conducting and identifying of the business of Opposers and its affiliates; and such marks and names distinguish such goods, such services and such business from those of others.

10. Opposers and their affiliates have been using the FIRESTONE names and marks as well as the Bridgestone/Firestone name in connection with their goods, services, and businesses since long prior to any date on which Applicant may rely in this proceeding, namely, well before the filing date of the application herein opposed.

11. The FIRESTONE names and marks for “rubber tires” and for other goods and services, as well as the Bridgestone/Firestone name, on the one hand, and the “MILESTONE ROAMER” mark as sought to be registered by Applicant for “tires for vehicle wheels”, on the other

hand, are similar in sight, sound, spelling and appearance. Thus, the mark sought to be registered by Applicant so resembles the marks and names of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, as to be likely to cause confusion, or to cause mistake, or to deceive.

12. The “tires for vehicle wheels” identified by the Applicant’s designation “MILESTONE ROAMER” and the “rubber tires” identified by Opposers’ FIRESTONE marks and names and by the Bridgestone/Firestone name are identical. Applicant’s goods and Opposers’ goods and other services and businesses are closely related kinds of goods, services and businesses and are typically offered and provided to the same classes of purchasers through the same channels of trade.

13. Through use and promotion by Opposers and their affiliates of Opposers’ FIRESTONE marks and names and of the Bridgestone/Firestone name for Opposers’ goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and business of Opposers.

14. Purchasers and prospective purchasers familiar with Opposers’ goods, services and businesses identified by the FIRESTONE marks and names and by the Bridgestone/Firestone name are likely to be misled into believing, contrary to fact, that Applicant’s goods sold under the mark opposed herein emanate from or are in some way sponsored by Opposers or their affiliates, all to Opposers’ irreparable damage through loss and/or dilution of their good will as symbolized by Opposers’ marks and names.

15. Granting of a registration as sought by Applicant through the application herein opposed would place Applicant in a position to harass and cause annoyance to Opposers and their customers, to the damage of Opposers. Such registration would inhibit Opposers in their free use of their FIRESTONE marks and names and their Bridgestone/Firestone name in selling their products, promoting their services, and conducting their business, which would work manifest damage upon Opposers. Finally, such registration would constitute *prima facie* evidence of an exclusive right to use the designation "MILESTONE ROAMER" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposers.

16. In view of extensive promotion and use thereof for more than a century and in view of the widespread renown and recognition thereby developed, Opposers' FIRESTONE marks and names have long been famous marks and names. The Bridgestone/Firestone name is also famous. Such marks and names have been famous since long before any date on which Applicant may rely for priority purposes in this proceeding. Applicant's MILESTONE ROAMER mark, which is the subject of the application opposed herein, causes and will cause dilution of the distinctive quality of Opposers' famous FIRESTONE mark and name and of the Bridgestone/Firestone name, all to the further damage of Opposers.

17. The application opposed herein was filed on February 8, 2002, which was subsequent to January 16, 1996, the effective date of the federal anti-dilution statute reflected in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to

being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of Opposers' famous marks and names.

18. For at least the above reasons, registration of Applicant's Serial No. 76/369,339 is herein opposed on the grounds that Applicant's proposed MILESTONE ROAMER mark so resembles Opposers' FIRESTONE marks and names and the Bridgestone/Firestone name as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory law and common law.

19. Additionally, registration of Applicant's MILESTONE ROAMER mark is opposed on the grounds that it will dilute the distinctive quality of opposers' FIRESTONE marks and names and the Bridgestone/Firestone name under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and under state anti-dilution statutes.

20. Registration of the mark shown in the subject application is also opposed on the grounds that Applicant does not own any trademark rights in the designation MILESTONE ROAMER.

21. Tires bearing the designation MILESTONE ROAMER are manufactured in China by a company that is unrelated to the Applicant.

22. Although the subject Application was filed based on intent to use, tires bearing the designation MILESTONE ROAMER are presently sold in the U.S.

23. Applicant's customers are tire wholesalers and/or tire distributors located in the United States. Applicant receives orders for tires from its customers and then passes the orders on to its Chinese supplier.

24. Tires are then shipped directly from the Chinese supplier to Applicant's customer.

25. Except in rare circumstances, Applicant does not actually see the physical tires that are shipped to its customers, and is not in a position to observe or control the manufacture or quality of the tires.

26. Applicant never has had and still does not have any influence over or input into the specifications of the tires.

27. Even when MILESTONE or MILESTONE ROAMER brand tires are specified in the purchase order sent by Applicant to the Chinese supplier, Applicant does not know and has no control over what brand of tire is or will be shipped from the Chinese supplier directly to Applicant's customers. The actual brand shipped is often a brand other than the MILESTONE or MILESTONE ROAMER brand that was ordered.

28. For these reasons, registration of the designation MILESTONE ROAMER mark is also opposed on the grounds that the application is void *ab initio* because Applicant is not the owner of the mark within the meaning of section 1 of the Lanham Act, 15 U.S.C. § 1051, and is therefore not entitled to use or register the mark.

29. Alternatively, in the event that the Board were to determine that Applicant owns the mark, registration is opposed on the ground that Applicant abandoned any proprietary trademark

rights it may have once possessed by failing to exercise any control whatsoever over both the use of the mark and the nature and quality of goods bearing the mark.

30. Additionally, because Applicant has never exercised any control over the use of the designation MILESTONE ROAMER or the nature and quality of goods bearing the designation MILESTONE ROAMER, registration is opposed on the grounds that the application is void *ab initio* because at the time Applicant filed its application it did not have a bona fide intent to use the wording MILESTONE ROAMER in U.S. commerce in the manner of a trademark, within the meaning of Section 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1127.

WHEREFORE, Opposers request that this opposition be sustained and the subject application Serial No. 76/369,339 to register the mark MILESTONE ROAMER be refused registration.

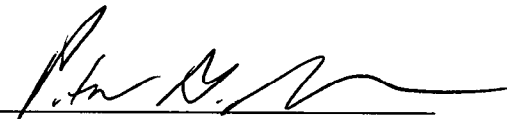
Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American Tire, LLC

Date : April 16, 2004

By:



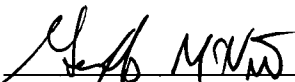
Peter G. Mack
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Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Tel: (202) 672-5300
Fax: (202) 672-5399
Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that I have this 16th day of April 2004, served a true and complete copy of the foregoing OPPOSERS' AMENDED NOTICE OF OPPOSITION upon Applicant by mailing a true copy of the same via first-class U.S. Mail, postage prepaid, to Applicant's counsel, addressed as follows:

Deborah J. Westervelt, Esq.
The Law Offices of Royal J. Craig
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202

By:



Geoffrey M. McNutt
FOLEY & LARDNER, LLP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposition No. 154,661

Application Serial No. 76/369,339

AMENDED NOTICE OF OPPOSITION (BLACK-LINE FORMAT)

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3. Opposers, as the successors in interest to Firestone, are the owner of all right, title and interest in and to various FIRESTONE marks for vehicle tires and for other goods and services. As used herein, "Opposers' goods," "Opposers' services," and "Opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Firestone, which is the ultimate predecessor in title of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC.

4. Opposer BFS Brands, LLC, is the owner of many U.S. Trademark and Service Mark Registrations featuring the mark FIRESTONE. Among such U.S. registrations are Reg. No. 140,804,

registered March 29, 1921, for the mark FIRESTONE in a stylized form for rubber tires and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. 299,977; Reg. No. 378,189; Reg. No. 396,796; Reg. No. 401,421; Reg. No. 948,402; Reg. No. 1,178,631; Reg. 1,387,468; Reg. No. 1,445,182; Reg. No. 1,471,665; Reg. No. 1,685,164; Reg. No. 2,223,630; Reg. No. 2,464,005; Reg. No. 2,507,769; and Reg. No. 2,582,878.

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8. Opposers use trade names and corporate identifiers dominated by the name "Bridgestone/Firestone." Such Bridgestone/Firestone name and identifier have been in use since long prior to any date on which Applicant may rely in this proceeding. In this regard, the ultimate parent

company of Opposers is Bridgestone Corporation; and the mark and name BRIDGESTONE is often used with the mark and name FIRESTONE to create a unitary impression conveyed by a composite of the two marks and names BRIDGESTONE and FIRESTONE. Also, Firestone has a website accessed, not only by its domain name <firestone.com>, but also by its domain name <bridgestone-firestone.com>. Thus, as used herein, the expression "Bridgestone/Firestone name" and expressions to the same effect encompass the aforesaid Bridgestone/Firestone trade name and corporate identifier, the aforesaid composite expression composed of the terms BRIDGESTONE and FIRESTONE, and the aforesaid <bridgestone-firestone.com> domain name.

9. The FIRESTONE names and marks and the Bridgestone/Firestone name are of significant value to Opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods and services of Opposers and their affiliates, as well as in the conducting and identifying of the business of Opposers and its affiliates; and such marks and names distinguish such goods, such services and such business from those of others.

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11. The FIRESTONE names and marks for "rubber tires" and for other goods and services, as well as the Bridgestone/Firestone name, on the one hand, and the "MILESTONE ROAMER" mark as sought to be registered by Applicant for "tires for vehicle wheels", on the other hand, are similar in sight, sound, spelling and appearance. Thus, the mark sought to be registered by Applicant so

resembles the marks and names of Opposer BFS Brands, LLC, and Opposer Bridgestone/Firestone North American Tire, LLC, as to be likely to cause confusion, or to cause mistake, or to deceive.

12. The “tires for vehicle wheels” identified by the Applicant’s designation “MILESTONE ROAMER” and the “rubber tires” identified by Opposers’ FIRESTONE marks and names and by the Bridgestone/Firestone name are identical. Applicant’s goods and Opposers’ goods and other services and businesses are closely related kinds of goods, services and businesses and are typically offered and provided to the same classes of purchasers through the same channels of trade.

13. Through use and promotion by Opposers and their affiliates of Opposers’ FIRESTONE marks and names and of the Bridgestone/Firestone name for Opposers’ goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and business of Opposers.

14. Purchasers and prospective purchasers familiar with Opposers’ goods, services and businesses identified by the FIRESTONE marks and names and by the Bridgestone/Firestone name are likely to be misled into believing, contrary to fact, that Applicant’s goods sold under the mark opposed herein emanate from or are in some way sponsored by Opposers or their affiliates, all to Opposers’ irreparable damage through loss and/or dilution of their good will as symbolized by Opposers’ marks and names.

15. Granting of a registration as sought by Applicant through the application herein opposed would place Applicant in a position to harass and cause annoyance to Opposers and their customers, to the damage of Opposers. Such registration would inhibit Opposers in their free use of

their FIRESTONE marks and names and their Bridgestone/Firestone name in selling their products, promoting their services, and conducting their business, which would work manifest damage upon Opposers. Finally, such registration would constitute *prima facie* evidence of an exclusive right to use the designation "MILESTONE ROAMER" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposers.

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17. The application opposed herein was filed on February 8, 2002, which was subsequent to January 16, 1996, the effective date of the federal anti-dilution statute reflected in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of Opposers' famous marks and names.

18. For at least the above reasons, registration of Applicant's Serial No. 76/369,339 is herein opposed on the grounds that Applicant's proposed MILESTONE ROAMER mark so resembles

Opposers' FIRESTONE marks and names and the Bridgestone/Firestone name as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory law and common law.

19. Additionally, registration of Applicant's MILESTONE ROAMER mark is opposed on the grounds that it will dilute the distinctive quality of opposers' FIRESTONE marks and names and the Bridgestone/Firestone name under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and under state anti-dilution statutes.

20. Registration of the mark shown in the subject application is also opposed on the grounds that Applicant does not own any trademark rights in the designation MILESTONE ROAMER.

21. Tires bearing the designation MILESTONE ROAMER are manufactured in China by a company that is unrelated to the Applicant.

22. Although the subject Application was filed based on intent to use, tires bearing the designation MILESTONE ROAMER are presently sold in the U.S.

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26. Applicant never has had and still does not have any influence over or input into the specifications of the tires.

27. Even when MILESTONE or MILESTONE ROAMER brand tires are specified in the purchase order sent by Applicant to the Chinese supplier, Applicant does not know and has no control over what brand of tire is or will be shipped from the Chinese supplier directly to Applicant's customers. The actual brand shipped is often a brand other than the MILESTONE or MILESTONE ROAMER brand that was ordered.

28. For these reasons, registration of the designation MILESTONE ROAMER mark is also opposed on the grounds that the application is void *ab initio* because Applicant is not the owner of the mark within the meaning of section 1 of the Lanham Act, 15 U.S.C. § 1051, and is therefore not entitled to use or register the mark.

29. Alternatively, in the event that the Board were to determine that Applicant owns the mark, registration is opposed on the ground that Applicant abandoned any proprietary trademark rights it may have once possessed by failing to exercise any control whatsoever over both the use of the mark and the nature and quality of goods bearing the mark.

30. Additionally, because Applicant has never exercised any control over the use of the designation MILESTONE ROAMER or the nature and quality of goods bearing the designation MILESTONE ROAMER, registration is opposed on the grounds that the application is void *ab initio*

because at the time Applicant filed its application it did not have a bona fide intent to use the wording MILESTONE ROAMER in U.S. commerce in the manner of a trademark, within the meaning of Section 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1127.

WHEREFORE, Opposers request that this opposition be sustained and the subject application Serial No. 76/369,339 to register the mark MILESTONE ROAMER be refused registration.

Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American Tire, LLC

Date : April 16, 2004

By: _____
Peter G. Mack
Geoffrey M. McNutt
Foley & Lardner, LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Tel: (202) 672-5300
Fax: (202) 672-5399
Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that I have this 16th day of April 2004, served a true and complete copy of the foregoing OPPOSERS' AMENDED NOTICE OF OPPOSITION (BLACK-LINE FORMAT) upon Applicant by mailing a true copy of the same via first-class U.S. Mail, postage prepaid, to Applicant's counsel, addressed as follows:

Deborah J. Westervelt, Esq.
The Law Offices of Royal J. Craig
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202

By: _____

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Opposition No. 154,661

Application Serial No. 76/369,339

MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND
MEMORANDUM OF LAW IN SUPPORT OF THEREOF

Opposers hereby move for leave to amend their Notice of Opposition in this case in order to add additional grounds for opposition pursuant to Trademark Rule § 2.107 and Fed. R. Civ. P. 15. For the reasons set forth below, Opposers' proposed amendment is appropriate and should be accepted.

Accompanying this motion are copies of Opposers' proposed Amended Notice of Opposition, including a copy in black line format showing the changes from the original as well as a clean copy.

MEMORANDUM OF LAW

I. Introduction

Opposers BFS Brands, LLC, and Bridgestone/Firestone North American Tire, LLC (hereinafter referred collectively as “Opposers”) have filed a Notice of Opposition against an application for registration of the designation “MILESTONE ROAMER” for “tires for vehicle wheels” filed by Orteck International, Inc. (hereinafter “Applicant”). Opposers seek leave to amend their Notice of Opposition to assert as additional grounds for opposition that the subject application is void because Applicant does not own any trademark rights in the designation MILESTONE ROAMER.

Opposers’ Amended Notice of Opposition is appropriate and should be accepted because liberal leave is given in allowing amendments to pleadings; because Applicant first learned of the additional grounds for opposition during discovery; because the raising of the additional grounds at this time would not prejudice Applicant; and because amendment is necessary for full and efficient adjudication on the merits.

II. Standard

Trademark Rule 2.107 provides that pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court. Fed. R. Civ. P. 15(a) allows amendments to pleadings by leave of court, and leave to amend shall be freely given when justice so requires. Thus, the TTAB freely grants leave to amend pleadings, unless entry of the proposed amendment violates settled law or is prejudicial to the rights of the adverse party. *See Flatley v. Trump*, 11 U.S.P.Q.2d 1284 (TTAB 1989); *see e.g., Time Warner Entertainment Co., L.P. v. Keyes*, 2003 TTAB LEXIS 361, *2 (TTAB 2003)

(unpublished) (granting the opposer's motion to file an amended notice of opposition which added additional grounds for opposition based on lack of ownership and abandonment).

III. Information Obtained Through Discovery

Applicant applied for registration of the mark "MILESTONE ROAMER" for "tires for vehicle wheels", Serial No. 76/369,339, on February 8, 2002. The application was published for opposition in the Official Gazette on July 30, 2002. Opposers filed its Notice of Opposition on October 28, 2002. Opposers have opposed registration on the ground that the designation MILESTONE ROAMER on tires so resembles Opposers' famous FIRESTONE marks and names and BRIDGESTONE/FIRESTONE name and corporate identifier as to create a is likelihood of confusion, and that the designation MILESTONE ROAMER dilutes the distinctive quality of Opposers' famous FIRESTONE mark and name.

On December 9, 2003, Opposers took the discovery deposition of Mr. Sanjeet Veen, Applicant's designated corporate witness pursuant to Fed. R. Civ. P. 30(b)(6). Mr. Veen is Vice President of purchasing and administration for Applicant. *See* Exhibit A, 30(b)(6) Deposition Transcript of Sanjeet S. Veen, p. 3:15-3:16 (hereinafter "Veen Dep."). On December 9, 2003, Opposers also deposed Mr. Elmer Grap, an independent consultant for Applicant, who markets Applicant's products to tire wholesalers and/or distributors. *See* Exhibit B, Deposition Transcript of Elmer Grap, p. 3:15-4:9 (hereinafter "Grap Dep."). Based on these depositions, Opposers first discovered that Applicant exercises none of the rights or duties consistent with or indicative of ownership of a trademark rights. However, following the depositions, Applicant designated as confidential the portions of the deposition transcripts of Mr. Veen and Mr. Grap that revealed the identity of Applicant's Chinese supplier. It was not until March 26, 2004 that Applicant's counsel, in response to Opposers' request, agreed to withdraw the confidentiality

designations relating to Applicant's Chinese supplier. *See* Exhibit C, Letter from Ms. Deborah J. Westervelt to Mr. Peter Mack dated May 26, 2004.

The depositions of Mr. Veen and Mr. Grap revealed that Applicant rarely sees the MILESTONE or MILESTONE ROAMER tires that are shipped directly to its customers from China, that Applicant is not in a position to observe or control the manufacture or quality of the tires, that Applicant has never had any input into the specifications of the tires, and that Applicant has no control of the use of the mark or the brand of tire that is shipped from Applicant's Chinese supplier directly to Applicant's customers in the United States.

Applicant does not sell tires directly to the end user. Rather, Applicant's customers are tire wholesales and tire distributors. Applicant's receives orders for tires from tire wholesales and tire distributors and forwards the orders to a supplier in China named K&S International ("K&S"). K&S then ships the tires directly to the wholesaler or distributor in the United States.

Applicant does not place the MILESTONE ROAMER brand, or any other brand, on its goods.¹ *See* Veen Dep. 26:18-26:21. Rather, Applicant's supplier, K&S, applies the brands to the goods using a variety of different marks among which is the MILESTONE ROAMER mark. *See* Veen Dep. 15:3-15:18.

Applicant does not specifically order MILESTONE ROAMER brand tires. Rather, Applicant gives its supplier "a few options of various brands, and whatever is easiest and available at that time, they ship that particular brand." Veen Dep. 26:5-26:14, 15:22-16:5. Moreover, even when MILESTONE or MILESTONE ROAMER brand tires are specified in the purchase order sent by Applicant to the Chinese supplier, Applicant does not know and has no

¹ Although the Applicant's application is based on an intent-to-use the mark, the evidence shows that the mark has been used since at least as early as 2001. *See* Veen Dep. 21:11-21:18.

control over what brand of tire is or will be shipped from the Chinese supplier directly to Applicant's customers. *See* Veen Dep. 107:4-108:8. The actual brand shipped is often a brand other than the MILESTONE or MILESTONE ROAMER brand that was ordered. *Id.*

In fact, Applicant has no input over the specifications of the tires supplied by K&S. *See* Veen Dep. 15:6-15:10. Applicant does not even select the features for the tires that it orders from K&S. *See* Veen Dep. 86:17-86:19.

Moreover, except in rare circumstances, Applicant does not actually see the physical tires, because the tires are shipped directly from K&S to Applicant's customers in the United States. *See* Veen Dep. 18:18-18:20, 91:11-91:19, 95:18-95:20; Grap Dep. 15:2-15:11. The tires are shipped from K&S to Applicant's customers in large ocean containers, and Applicant typically does not even know the brand name of the tires that are ultimately delivered to particular customers. *See* Grap Dep. 21:4-21:9; Veen Dep. 27:22-28:4, 36:6-36:10.

In fact, Applicant's witnesses testified that the particular trademark or brand name of the tires has no bearing on whether or not its customer will ultimately purchase the goods from Applicant. *See* Veen Dep. 96:10-96:16; Grap Dep. 23:22-24:15. Applicant's customers typically order their tires based on size not brand name. *See* Grap Dep. 20:19-21:9.

Moreover, Applicant does not even know whether K&S sells MILESTONE ROAMER tires to entities other than the Applicant. *See* Veen Dep. 16:6-16:12, 28:5-28:10; Grap Dep. 23:6-23:14. Applicant also does not even know if anyone other than Applicant is using the designation MILESTONE or MILESTONE ROAMER on tires in the United States. *See* Veen Dep. 38:5-38:15.

Based on this newly discovered information, Applicant is not entitled to registration of the mark that is the subject of opposed application Serial No. 76/369,339 because Applicant is

not the owner of the mark within the meaning of section 1 of the Lanham Act, 15 U.S.C. § 1051. Alternatively, Applicant abandoned any trademark rights it may have possessed as a result of its complete failure to exercise any control whatsoever over both the use of the mark and the nature and quality of the goods bearing the mark. *See Heaton Enters. of Nevada, Inc. v. Lang*, 7 U.S.P.Q.2d 1842 (TTAB 1988) (citing *Haymaker Sports, Inc. v. Turian*, 198 U.S.P.Q. 610 (C.C.P.A. 1978)).

Additionally, because Applicant has never exercised any control over the use of the designation MILESTONE ROAMER or the nature and quality of goods bearing the MILESTONE ROAMER designation, Applicant, at the time it filed its trademark application, did not have a bona fide intent to use the wording MILESTONE ROAMER in U.S. commerce in the manner of a trademark within the meaning of Sections 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1127.

IV. There is No Prejudice to Opposer

Applicant cannot possibly be prejudiced by amendment to the Notice of Opposition because: (1) the discovery period is still open; and (2) all information regarding the additional grounds for opposition are in the possession and/or control of Applicant.

A. The Discovery Period is Still Open

The TTAB has held that when a motion to amend the pleadings is filed prior to the close of discovery, there typically is no prejudice to the non-moving party because the non-moving party will have an opportunity to take discovery on the matters raised in the proposed amended pleading. *See Commodore Electronics Ltd. v. Cbm Kabushiki Kaisha Opposition*, 26 U.S.P.Q.2d (BNA) 1503 (TTAB 1993); *Anheuser-Busch, Inc. v. Martinez*, 185 U.S.P.Q. 434, 435 (TTAB

1975) (stating that because the proceeding was still in the pre-trial stage, applicant's amendment of the pleadings could "in no way prejudice opposer").

On March 27, 2004, the TTAB granted Opposers'/Applicant's consented motion, filed March 5, 2004, to extend discovery and trial dates. Thus, the TTAB extended the close or discovery up to and including May 5, 2004. In addition, testimony periods are not set to close until at least August 3, 2004. Therefore, because Applicant has the opportunity to take discovery on the additional grounds for opposition in the Amended Notice of Opposition, Applicant will not be prejudiced by the amendment.

B. All Information is in the Possession and/or Control of Applicant

Regardless of when the discovery period closes, Opposers' Amended Notice of Opposition cannot and does not prejudice Applicant because the additional grounds raised therein arise from Applicant's activities and Applicant's relationship with its Chinese supplier. Opposers possess no unique information relating to any of these issues. The information which forms the grounds for the new allegations in Opposers' Amended Notice of Opposition was learned from Applicant during discovery. Applicant's own documents and employees have disclosed the facts that create grounds for challenging Applicant's ownership of the mark. Opposers do not possess and/or control any of the possible discoverable materials relevant to this additional grounds for opposition. Rather, information relevant to these issues is already known to Applicant and in Applicant's possession.

V. Justice and Efficiency

Opposers' motion to amend the Notice of Opposition should also be granted in the interests of justice and legal efficiency.

Opposers' were not aware of the facts asserted in their proffered Amended Notice of Opposition until the discovery depositions of Mr. Veen and Mr. Grap on December 9, 2003. Prior to that time, Opposers had no reason to suspect that Applicant does not own or control the proposed mark MILESTONE ROAMER. Additionally information regarding Applicant's Chinese supplier, including relevant portions of the deposition transcripts of Mr. Veen and Mr. Grap, had been previously designated confidential by Applicant. In reply to Opposers' request, Applicant's counsel agreed to withdraw the confidentiality designations relating to Applicant's Chinese supplier in a letter dated March 26, 2004. *See Exhibit C, Letter from Ms. Deborah J. Westervelt to Mr. Peter Mack dated May 26, 2004*. Upon withdrawal of these confidential designations, Opposers could incorporate facts learned during discovery into the Amended Notice of Opposition and file the present motion and memorandum without the awkward and inefficient procedure that would have been required if the Amended Notice of Opposition and this motion had to be filed under seal.

Because information indicating that Applicant does not own the mark and does not have a bona fide intent to use the designation MILESTONE ROAMER as a trademark was first learned during the depositions of Mr. Veen and Mr. Grap, this proceeding was the first opportunity for Applicant's lack of ownership of the mark to have been discovered.² The TTAB should grant Opposers motion to amend the Notice of Opposition so that all grounds for opposition may be adjudicated in one proceeding. *See Space Base, Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216 (TTAB 1990) (granting motion for leave to amend the Notice of Opposition to add counterclaim because

² Examining Attorneys generally do not inquire into an applicant's asserted intent to use a mark or ownership of a mark during *ex parte* examination. *See T.M.E.P.* §§ 1201, 1201.01.

interests of justice and judicial economy would best be served by permitting all claims to be adjudicated in one proceeding).

VI. Conclusion

In sum, Opposers Motion to Amend the Notice of Opposition should be granted because: (1) the liberal policy established by the Federal Rules of Civil Procedure concerning amendments to pleadings dictates allowance of Opposers' motion to amend the Notice of Opposition; (2) Opposers only first learned of the additional grounds for opposition during discovery and promptly filed this motion after clearing up some confidentiality issues; (3) Applicant will not be prejudiced by the amendment because discovery is still open; (4) Applicant will not be prejudiced by the amendment because all discoverable information relating to the added grounds for opposition are in the possession and/or control of Applicant alone; and (5) interests of justice and judicial efficiency require full adjudication of the claims on the merits in one proceeding.

WHEREFORE, for the reasons above, Opposers respectfully request that this motion be granted and that the proposed Amended Notice of Opposition be accepted and entered.

Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American Tire, LLC

Date : April 16, 2004

By:



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Geoffrey M. McNutt

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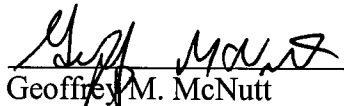
Fax: (202) 672-5399

Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that I have this 16th day of April 2004, served a true and complete copy of the foregoing OPPOSERS' MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND MEMORANDUM OF LAW IN SUPPORT THEREOF (with Exhibits A through C) upon Applicant by mailing a true copy of the same via first-class U.S. Mail, postage prepaid, to Applicant's counsel, addressed as follows:

Deborah J. Westervelt, Esq.
The Law Offices of Royal J. Craig
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202

By: 
Geoffrey M. McNutt
FOLEY & LARDNER, LLP

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3 In the matter of Trademark Application

4 Serial No.: 76/369,339

5 Trademark: MILESTONE ROAMER

6 - - - - - x

7 BFS BRANDS, LLC :

8 and :

9 BRIDGESTONE/FIRESTONE :

10 NORTH AMERICAN TIRE, LLC, : Opposition No.

11 Opposers, : 154,661

12 vs. :

13 ORTECK INTERNATIONAL, INC., :

14 Applicant. :

15 - - - - - x

16

17 30(b)(6) DEPOSITION OF SANJEET S. VEEN

18 Washington, DC

19 Tuesday, December 9, 2003

20

21 REPORTED BY:

22 CARMEN SMITH

ACE-FEDERAL REPORTERS, INC.

Nationwide Coverage

202-347-3700

800-336-6646

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22 On behalf of Applicant and Witness

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P R O C E E D I N G S

Whereupon,

SANJEET S. VEEN

having first been duly sworn, was examined and
testified as follows:

EXAMINATION

BY MR. MACK:

Q Would you please state your full name for
the record?

A Sanjeet S. Veen, S-a-n-j-e-e-t, middle
initial S, last name V-e-e-n.

Q And you are employed by Orteck
International, Inc.; is that correct?

A Yes.

Q Can you tell me your position there?

A VP of purchasing and administration.

Q And you are here today to testify on
behalf of the company in connection with various
topics in this case; is that correct?

A Yes.

Q And I would like to mark the first
exhibit.

1 back as Milestone Roamer and adopted that name from
2 there on.

3 Q Do I understand correctly that a Chinese
4 company makes the Milestone Roamer tire?

5 A We buy it from a Chinese company.

6 Q In buying the tires from the Chinese
7 company, are they made to your specifications?

8 A No.

9 Q What is the name of the Chinese company?

10 A We buy from KNS International.

11 Q Do you know where in China they are
12 located?

13 A Beijing.

14 Q Now, do the tires that you buy from KNS
15 International, are they branded as Milestone Roamer
16 tires in China prior to your purchase?

17 A We buy many brands from them, Milestone
18 Roamer being one of them.

19 Q Is the Milestone Roamer a brand that was
20 created by the Chinese company?

21 A I'm not sure.

22 Q Is it correct that Orteck does not specify

1 to the Chinese company, KNS International, to put
2 the Milestone Roamer brand on the tires?

3 A We give them a few options, and whatever
4 is the best and the easiest procurement avenue for
5 them, they supply us in that brand.

6 Q To your knowledge, does KNS International
7 sell Milestone Roamer tires to others besides
8 Orteck?

9 A I'm not sure.

10 Q Do you know if anybody at Orteck would
11 know that?

12 A No, I don't think so.

13 Q How about in terms of the original
14 creation of the brand, do you know whether anyone
15 else at Orteck would know whether or not the
16 creation of the brand came from KNS International
17 originally?

18 A I'm the only one in order of purchasing,
19 no one else at Orteck has dealings with suppliers,
20 except me.

21 Q You may have already answered this but I'm
22 going to ask it a different way. Do you know

1 the Milestone Roamer name came from?

2 A It was also created during our
3 discussions. I'm not sure how it came about, but it
4 was during our discussions, that was a name
5 suggested and adopted.

6 Q Do I understand correctly that you import
7 Milestone Roamer tires directly from China?

8 A Yes.

9 Q Do you know when the first tires came into
10 this country?

11 A 2001.

12 Q Did those tires have both Milestone and
13 Roamer on them?

14 A I physically didn't see them, but I
15 believe so.

16 Q Have you ever seen the Milestone Roamer
17 tires physically?

18 A A few. We normally don't see the tires,
19 we just sell in containerloads, but a few tires we
20 get sometimes a chance to see.

21 Q We talked in terms of the application to
22 register simply Milestone and then there's the

1 "Roamer"?

2 A In 2001 and probably some part of 2002.
3 But like I said, we don't see the tires physically,
4 so that is just a guesstimate.

5 Q Well, you made purchasing decisions. Do
6 you specify what brand will be on the tire?

7 A I give the factory a few options of
8 various brands, and whatever is easiest and
9 available at that time, they ship that particular
10 brand.

11 Q When you say you give the factory a few
12 options, what are the options you give them?

13 A The Milestone Roamer, Treva, BCT, Doral.
14 This is what I can think of right now at the moment.

15 Q So are you saying you give the factory a
16 few options, you give them a few options as to what
17 brand to place on the tires?

18 A No. We buy; we aren't placing any brand
19 on the tire. We generally like to buy these tires,
20 they could give us -- we give them a few options,
21 and we could buy the tires in any of these brands.

22 Q Are any of the brands other than Milestone

1 Roamer brands that Orteck considers itself to be the
2 owner of in the United States?

3 A Treva, I believe so.

4 Q Do you know whether that's registered?

5 A I think so.

6 Q Do you know whether Orteck has any other
7 registered marks?

8 A This is all I can think of right now.

9 Q Can you think of any that are pending,
10 awaiting registration?

11 A I can't think of.

12 Q Were you involved in the creation of the
13 Treva mark?

14 A Yes.

15 Q Was it your idea to use that as a
16 trademark?

17 A It was a few -- a few heads together from
18 us and KNS came up with that name.

19 Q Any other people at Orteck besides
20 yourself?

21 A No.

22 Q Now, in terms of giving KNS options as to

1 what brands to supply, do you end up learning what
2 options they decided to exercise, in other words,
3 what brand they ship to you?

4 A Not always and not very accurately.

5 Q Are tires made by KNS sold through other
6 companies in the United States besides Orteck?

7 A I don't know.

8 Q How about Malhotra, do you know if tires
9 made by them are sold by others than Orteck?

10 A No.

11 Q Let's start generally with the overall
12 product line of Orteck and then we'll focus in later
13 on Milestone Roamer. Can you describe for me the
14 kinds of tires that are sold by Orteck? In other
15 words, what are the tires ultimately used for?

16 A Automotive, farm, industrial, agriculture
17 and various miscellaneous.

18 Q Is any one of those areas more prominent
19 for Orteck than the other?

20 A I don't believe so.

21 Q Do the brands vary depending on whether
22 it's automotive or agricultural, for example?

1 Q Let's assume we're looking at tires that
2 Orteck has bought in this country. Are your sales
3 to your customers generally in the quantities of
4 truckloads or containerloads?

5 A Majority of it is.

6 Q And do you know what brand names, if any,
7 appear on the truckloads or containerloads of tires
8 that have been purchased by Orteck in this country
9 and then sold to a customer?

10 A Not always.

11 Q Is the situation similar to what you
12 described with the containerloads from China?

13 A Yes.

14 Q Since your adoption of it, has the
15 Milestone Roamer become a well-known trademark in
16 your view?

17 A I don't think so.

18 Q How about Firestone, is that a well-known
19 trademark?

20 A I don't know.

21 Q Bridgestone, is that well-known?

22 A I'm not very sure. Yeah, I know class

1 any of your customers as to whether there's any
2 connection between Milestone Roamer and
3 Bridgestone/Firestone?

4 A No.

5 Q Do you know of anyone other than Orteck
6 who is using the brand name Milestone for tires in
7 the United States?

8 A I don't know.

9 Q And is the same true for Milestone Roamer?

10 A Yeah, I don't know.

11 Q And please pardon me if this is
12 repetitious, but you don't know whether Milestone
13 Roamer tires are sold by anyone else in any other
14 countries than the United States; is that right?

15 A I don't know.

16 Q Do you have any agreement with KNS not to
17 sell Milestone or Milestone Roamer tires to anyone
18 other than Orteck?

19 A I'm not sure.

20 Q Who would know that at Orteck?

21 A I would know, but I have to check my
22 records. I'm not sure if we ever made any such

1 A I believe so.

2 Q I believe this is similar to a part of the
3 Web site as well that we looked at earlier; correct?

4 A Yes. I would also like to add a statement
5 here that of a catalogue, which is 22, 24 pages,
6 only one page is Milestone Roamer; other 19 pages of
7 catalogues are dedicated to other different brands
8 which have nothing to do with Milestone or Milestone
9 Roamer.

10 Q In Exhibit 14, there are various tire
11 features that are mentioned at the top under
12 Milestone Roamer next to the bullet points.

13 A Right.

14 Q Do those features come from information
15 supplied to you by KNS?

16 A Yes.

17 Q Do you get involved in selecting the
18 features for the tires that you buy from KNS?

19 A No.

20 (Opposers' Exhibit 15 identified.)

21 BY MR. MACK:

22 Q You've been handed a document marked as

1 A That's a tire broker.

2 Q Does a substantial part of your business
3 come through tire brokers?

4 A I wouldn't say "substantial," but a good
5 part.

6 Q Do you know what brand names appear on the
7 tires covered by this invoice of Opposers' Exhibit
8 16?

9 A No. It could be any of the brands that
10 suppliers give us.

11 Q I see it says "ship from China." So does
12 the shipment go directly from KNS International to
13 Thompson Tire?

14 A That's right.

15 Q Is that the most common way in which you
16 sell tires?

17 A That's the way we do business. We ship
18 containerloads directly to the wholesalers or any
19 location that they provide.

20 Q And is this a typical quantity and dollar
21 amount for a container full of tires?

22 A Yes.

1 Q Do you know where the 40 percent came
2 from?

3 A Not really. I guess it's more of from the
4 light truck, the three brands that are made, so
5 guesstimate 40 percent could be Milestone. But
6 again, that's a guess figure. We really don't see
7 physically any tires, so that is of the total light
8 truck volume, 40 percent we assume would be
9 Milestone.

10 Q Correct me if I'm wrong, but I think
11 earlier you mentioned that you thought last month,
12 that maybe 15 percent of the light truck tires were
13 Milestone?

14 A No, 15 percent of total company sales.
15 This is 40 percent of light truck only.

16 Q And is that typical of what you believe
17 the percentage of Milestone tires are?

18 A That is a principle that we go by. In
19 actuality, nobody really sees the tires, so we don't
20 know.

21 Q Have you ever known of anybody to actually
22 ask for a Milestone or Milestone Roamer brand tires?

1 A Not specifically.

2 Q Do you know if Milestone or Milestone
3 Roamer brand tires have developed any kind of
4 reputation in the marketplace?

5 A I don't know.

6 Q Do you know whether they're recognized by
7 ultimate consumers as being a brand that they have
8 heard of?

9 A In my personal opinion, I don't think so.

10 Q Do you believe that the particular brand
11 that appears on your tires, and I'm speaking of
12 light truck tires, whether the Milestone Roamer,
13 Doral or Treva affects whether or not the customer
14 will ultimately purchase the tire?

15 A In my opinion, it has no bearing. The
16 brand name has no bearing.

17 Q Do you believe it's mainly price that the
18 customer is interested in?

19 A "Customer" is a very ambiguous word. Our
20 customer is a tire wholesaler, and in my opinion,
21 tire wholesaler is basically interested in service,
22 which I explained to you before what I mean by

1 people who are involved in logistics and
2 transportation. But I review them sometimes, not
3 day to day.

4 Q Now, this particular document, as I
5 understand it, in the far right column does specify
6 the brand of tires being ordered from KNS.

7 A Right.

8 Q You know that this document specifically
9 relates to KNS?

10 A That's -- I think it relates to KNS.

11 Q And where we see "i-l-e-s-t-o-n-e," that
12 actually would be Milestone; is that right?

13 A Could be Milestone or Milestone Roamer.
14 See, I think it's being truncated off.

15 Q And do I understand correctly that
16 although a brand is specified here, that that's not
17 necessarily what will show up in the containers?

18 A That's right. We just put them at random,
19 we divide them equally and send it to the factory,
20 but it doesn't mean that it will come like that. It
21 will come in anything.

22 Q They will provide the sizes ordered, but

1 it could be any one of the brands that they use for
2 light truck tires; is that right?

3 A Whatever they have available at that time
4 in their warehouse.

5 Q And they ship directly to your customer;
6 is that correct?

7 A Yes, to the wholesalers or to a location
8 appointed by them.

9 Q And that fairly wide column in the middle
10 in the very first line containing Lincoln, Nebraska
11 is the place designated by your customer as the
12 place to which the tires are to be shipped?

13 A Right.

14 Q And the column next to that shows the port
15 of entry?

16 A That's right.

17 Q And the next to last column next to the
18 brands, that shows quantities?

19 A Approximate quantities that we request but
20 that doesn't tally toward the ship. It's almost
21 most of the times different from what we request,
22 because they ship what they have, the brands they

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
3 In the matter of Trademark Application
4 Serial No.: 76/369,339
5 Trademark: MILESTONE ROAMER
6 - - - - - x
7 BFS BRANDS, LLC :
8 and :
9 BRIDGESTONE/FIRESTONE :
10 NORTH AMERICAN TIRE, LLC, : Opposition No.
11 Opposers, : 154,661
12 vs. :
13 ORTECK INTERNATIONAL, INC., :
14 Applicant. :
15 - - - - - x

16
17 DEPOSITION OF ELMER GRAP

18 Washington, DC
19 Tuesday, December 9, 2003

20
21 REPORTED BY:
22 CARMEN SMITH

Deposition of ELMER GRAP, called for examination pursuant to notice of deposition, on Tuesday, December 8, 2003, in Washington, DC, at the offices of Foley & Lardner, 3000 K Street Northwest, at 3:02 p.m., before CARMEN SMITH, a Notary Public within and for the District of Columbia, when were present on behalf of the respective parties:

PETER G. MACK, ESQ.

Foley & Lardner

Washington Harbour

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Washington, DC 20007-5143

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On behalf of Opposers

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On behalf of Applicant

1 P R O C E E D I N G S

2 Whereupon,

3 ELMER GRAP

4 having first been duly sworn, was examined and
5 testified as follows:

6 EXAMINATION

7 BY MR. MACK:

8 Q Good afternoon, Mr. Grap.

9 A Hello.

10 Q Can you please state your name for the
11 record?

12 A Elmer Thomas Grap III.

13 Q And you're known by the nickname "Boots"?

14 A "Boots," right.

15 Q What is your occupation?

16 A I'm sorry?

17 Q Occupation?

18 A I'm called executive vice president, but
19 I'm mainly a consultant.

20 Q Where you're called executive vice
21 president, is that of Orteck International?

22 A Yes.

1 Q As I understood, you're not actually an
2 employee of Orteck; is that right?

3 A That's correct.

4 Q Independent contractor?

5 A That's correct.

6 Q And what is your role at Orteck as an
7 independent contractor?

8 A I market the products that they provide to
9 consumers.

10 Q What do you mean by "consumers"?

11 A Wholesalers, brokers.

12 Q Do you ever have occasion in connection
13 with your work for Orteck to come into contact with
14 actual ultimate consumers of tires sold by Orteck?

15 A No.

16 Q How about retailers? Do you ever come
17 into contact with the retailers of the Orteck tires?

18 A No.

19 Q Do you know what Orteck's customers do
20 with the tires after they have purchased them from
21 Orteck? In other words, what is the next stage in
22 the distribution channel, if you know?

1 them?

2 Q Let me back up. As I understand the
3 marketing approach that is used by Orteck, orders
4 are taken from tire wholesalers or distributors for
5 entire ocean shipping containers full of tires.

6 A That's correct.

7 Q And they are shipped directly from the
8 manufacturer to Orteck's customer, so that Orteck
9 normally will not actually see the physical tires
10 that it has sold.

11 A That's correct.

12 Q But there are occasions, as I understand
13 what you said, where you do actually see the
14 physical tires.

15 A Sure.

16 Q And how does that happen?

17 A You go to a trade show or your customer
18 goes to a trade show or a worker goes to a trade
19 show.

20 Q What trade shows are we talking about
21 here?

22 A The one in Las Vegas, the SEMA show.

1 Q And how do you position Orteck? What are
2 the selling points to a prospective customer for
3 dealing with Orteck?

4 A Well, the main thing I do is take care of
5 people. I have a good relationship with people,
6 meaning I communicate with them and I deliver them
7 what they need. If they want tires, I get them
8 delivered to them. If they need assistance with
9 specific consulting entities in their business, I
10 can help them with that, too. So I'm a little bit
11 more than just another pretty face.

12 Q So that's an additional benefit they get,
13 you help them out in the management of their
14 business?

15 A I can do multiple things for them, but the
16 main thing is building the relationships with
17 people. You get to know them, you go golfing with
18 them, you go on trips with them.

19 Q Have you ever known a customer to specify
20 that it wants Milestone or Milestone Roamer tires in
21 connection with one of the deals?

22 A No, huh-uh. That's not the way it works

1 necessarily.

2 Q The orders are placed based on size for
3 the most part?

4 A They're placed based on size and I tell
5 Mr. Veen, this is what I need, he gets it sent.
6 Sometimes we get this, sometimes we get that.

7 Q You don't really know what brand is going
8 to show up in a container?

9 A Not really.

10 Q And is it correct that the brands that
11 show up when the customer wants light truck tires
12 are Milestone Roamer, Doral and Treva?

13 A That's correct.

14 Q And to your knowledge, they all come from
15 China; is that right?

16 A That's right.

17 Q And they're from a company called KNS
18 International?

19 A That's the name of it I believe, KNS,
20 yeah.

21 Q Do you ever deal with them?

22 A No.

1 A I have a little satellite office there,
2 but I mainly work out of my house.

3 Q And you work the phones primarily in order
4 to help develop the business?

5 A Yes.

6 Q Do you know whether KNS sells Milestone or
7 Milestone Roamer tires to anybody else other than
8 Orteck in this country?

9 A I have no idea.

10 Q If they did, would that be considered --
11 would you consider that a problem in connection with
12 your marketing of Orteck tires?

13 A Not necessarily, I don't think so. Free
14 country, I guess.

15 Q Would that be true as well for the Treva
16 brand?

17 A I don't know -- I don't know a whole lot
18 about KNS, so I don't know if -- you know, all I
19 know is people kind of do what they want in the
20 United States. I don't know about foreign countries
21 and what they do.

22 Q In terms of what you do in your dealings

1 with the tire wholesalers and distributors who are
2 Orteck's customers, the brand of tire is irrelevant;
3 correct?

4 A They don't really care what the brand is.

5 Q Do I take it correctly that you don't know
6 one way or the other whether the ultimate consumer
7 cares about what the brand is?

8 A No, they don't care.

9 Q And how do you know that?

10 A Because we're selling tires. Somebody has
11 got to be -- somebody is getting them. I don't know
12 who's getting them.

13 Q So the consumers of those tires don't care
14 about the brand?

15 A Right.

16 Q Do you know whether the tires that are
17 sold by Orteck ultimately end up being sold side by
18 side at retail with famous brands, such as Michelin
19 and Goodyear?

20 A No idea.

21 Q Do you know whether the customers of
22 Orteck also carry brands of that nature?

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March 26, 2004

VIA FACSIMILE 202-672-5399 (w/o attachments)
CONFIRMATION BY US MAIL (w/attachments)

Peter Mack, Esq.
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LAW
BUSINESS
TECHNOLOGY

Re: Opposition No. 154,661;
BFS Brands, L.L.C., et al. v. Orteck International, Inc.

Dear Mr. Mack:

We have reviewed the Orteck confidentiality designations that you questioned and we agree to remove the designations identified below. Generally, a company's manufacturer/supplier falls squarely within the purview of a protective order. However, as you pointed out, Orteck's supplier ships directly to Orteck's customers, so we will waive the confidentiality designations for the manufacturer references as noted below.

The following confidentiality designations are withdrawn:

Deposition Testimony of Elmer Grap, page 21 through page 23, line 21.

Deposition Testimony of Sanjeet Veen:

1. Page 15, line 3 through page 16, line 9.
2. Page 16, line 13 through page 17, line 7.
3. Page 22, lines 16 through 19.
4. Page 23, lines 17 through 22.

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5. Page 27, line 17 through page 28, line 9.
6. Page 32, line 19 through line 22.
7. Page 38, lines 16 through 18.
8. Page 39, lines 2 through 3.
9. Page 39, lines 8 through 10.
10. Page 55, line 14.
11. Page 86, lines 14 through 19.
12. Page 88, lines 4 through 7.
13. Page 91, lines 11 through 13.
14. Page 92, lines 5 through 6.
15. Page 106, lines 15-16.
16. Page 107, lines 4 through 10.

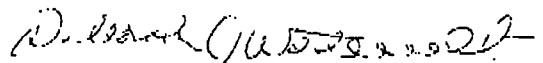
PLEASE NOTE that applicant agrees to withdraw all of the deposition testimony references in your letter of February 21, 2004, with the exception of Veen testimony, page 90, line 4 through page 91, line 1.

The confidentiality designations are also withdrawn from Applicant's Supplemental Responses to Interrogatory Nos. 13, 14, 21, and 22, and Orteck's Production No. A00001 and the brochures and catalogue pages identified by Orteck's document production Nos. A00002-A00004.

Lastly, the confidentiality designations for Orteck document Nos. A00009-A00016 are not withdrawn. The entire *Applicant's Second Supplemental Response to Opposer's First Request for Production of Documents and Things to Applicant* was designated as confidential and shall remain so designated. If your ambiguity allegation is based on the individual documents not being individually marked as confidential, we enclose copies of Documents A00009-A00016 marked confidential.

Best regards.

Sincerely,


Deborah J. Westervelt

cc. Orteck International, Inc.
Enc.